

**REMARKS**

The Examiner has stated that claims 1, 5, 6, 9-11, 14-16, 19-22, 44, 48, 55-88 are pending. Applicants respectfully submit that claims 3-6, 9, 11-12, 14-16, 19-22, 26-28, 30-32, 44, 48, 55-58, 60-67, and 69-88 are currently pending, and claims 1-2, 7-8, 10, 13, 17-18, 23-25, 29, 33-43, 45-47, 49-54, 59, and 68 were previously canceled. Applicants respectfully request that the Examiner clarify the status of claims 1, 3-4, 10, 12, 26-28, 30-32, 59, and 68.

By virtue of this response, claims 26-28 and 30-32 have been amended, no claims have been cancelled, and no new claims have been added. Accordingly, claims 3-6, 9, 11-12, 14-16, 19-22, 26-28, 30-32, 44, 48, 55-58, 60-67, and 69-88 are currently under consideration.

Claims 26-28 and 30-32 are amended to clarify that the composition, prior to implantation, is a solution or suspension. Support for the amended claims may be found throughout the specification and claims as originally filed, for example, *inter alia*, at paragraph [0020] of the specification. No new matter is added.

With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter and, moreover, have not acquiesced to any rejections and/or objections made by the Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuations, continuation-in-part, and/or divisional applications.

***Claim Objection***

Claim 14 is objected to as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully wish to bring the Examiner's attention to the fact that claim 14 depends from claim 30, and not claim 26. Claim 30 does not include the limitation "wherein at least 55 wt% of the solvent mixture in said composition is the hydrophobic solvent" as is claimed in claim 14. Accordingly, Applicants submit that claim 14 is in proper dependent format.

Accordingly, Applicants respectfully request withdrawal of the claim objection.

***Claim Rejections – 35 USC § 103***

Claims 1, 5, 6, 9-11, 14, 16, 19-22, 44, 48, 55-58, 60-63, 66-73, 75-81 and 84-88 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over PCT/US97/23659 (Brodeck et al.), and claims 4, 15, 55, 64, 65, 82, and 83 are objected to as dependent upon a rejected base claim.

Applicants respectfully traverse.

As an initial matter, Applicants note that claims 1, 10, and 68 were previously canceled. Additionally, Applicants note that claims 4, 15, 55, 64, 65, 82, and 83 depend from claims 26, 30, 27, 28, 28, 32, and 32, respectively, which have not been rejected in the instant Office Action. For purposes of completeness, Applicants present the discussion below in response to the Examiner's rejection as it might be applied to all claims.

The Examiner has asserted that “[t]he claimed method differs only in the gauge of the needle used to administer the gel. However, adjustment of the viscosity for other methods of administration is taught at page 37, lines 13-19.” Applicants respectfully wish to bring the Examiner's attention to lines 17-19, wherein Brodeck teaches that adjustment of the viscosity can be accomplished through *emulsifying* agents. Applicants note that all pending claims are limited to compositions which are solutions or suspensions (see independent claims 26-28 and 30-32), which are distinct from emulsions. As noted in paragraph [0020] of the specification, a solution “means a liquid having multiple ingredients homogeneously distributed in a single phase”, and “[b]oth solutions and suspensions are contrasted with emulsions, which have more than one liquid phase.” There is no teaching at page 37, lines 13-19 to suggest that solutions or suspensions may be created which have a sufficiently low viscosity such that they may be administered through a 25, 28, or 30-gauge needle, as required by the instant claims.

Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. 103(a).

### **CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no.

**146392000500**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: January 9, 2009

Respectfully submitted,

Electronic signature: /Rebecca Shortle/  
Rebecca Shortle

Registration No.: 47,083  
MORRISON & FOERSTER LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
(650) 813-5654